

Application No. 10/057,027
Reply to Office Action of September 22, 2006

Atty. Docket No. 13077-00140-US

REMARKS

Favorable consideration of this Application as presently amended and in light of the following discussion is respectfully requested.

By way of summary, the Official Action presents the following issues: Claims 1, 4, 5, and 9 stand rejected under 35 U.S.C. § 112, first paragraph. The applicant respectfully traverses this rejection.

REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

The outstanding Official Action has rejected Claims 1, 4, 5, and 9 under 35 U.S.C. § 112, first paragraph, as based on a disclosure which does not have an adequate written description.

The first step for preparing the applicant's dispersion is preparing a 3,4-polyethylenedioxythiophene/ polystyrene sulphonate dispersion in accordance with example 2 of EP 0991303. This is disclosed in all the examples (examples 1-3) of the applicant's specification. Then additional steps are taken to prepare the applicant's inventive dispersion. A person skilled in the art would know how to make the dispersion according to the first step, i.e. example 2 of EP 0991 303 discloses the preparation of such a dispersion in a known manner -but a person skilled in the art would not know the additional steps for preparing the applicant's inventive dispersion.

In the applicant's response filed on September 9, 2004 it is stated, one having ordinary skill in the art would not know how to make the [applicant's claimed invention] dispersion comprising polyanions and cationic 3,4-polyalkylenedioxythiophenes and water or a water/alcohol mixtures as a solvent, wherein about 90% of the particles of the dispersion are less than 50 nm...

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To establish that "one skilled in the art would have known how to make" Applicants' invention, the Examiner must establish a prima facie case of obviousness....

The Examiner cites parts of the above response in a wrong way. EP 0991 303 does not disclose the preparation of the applicant's dispersion, but it describes — as mentioned above — the preparation of a "basic dispersion", which is the first step to make the applicant's claimed inventive dispersion. As already pointed out a person skilled in the art would know how to make this "basic dispersion". The additional steps which are necessary to prepare the applicant's inventive dispersion are described in the examples of the patent application. Therefore, the argument of the Examiner that the skilled artisan, having the originally filed specification would know how to make the applicant's invention as filed is wrong. To emphasize it again, the specification does have an adequate written description how to make our claimed invention as the preparation of the "basic dispersion" is known to a person skilled in the art. For the above reasons, this rejection should be withdrawn.

CONCLUSION

Consequently, in view of the foregoing amendment and remarks, it is respectfully submitted that the present Application, including claims 1, 4, 5 and 9 are patently distinguished over the prior art, and in condition for allowance, and such action is respectfully requested at an early date.

A two month extension fee has been paid. Applicant believes no additional fee is due with this request. However, if a fee is due, please charge our Deposit Account No.

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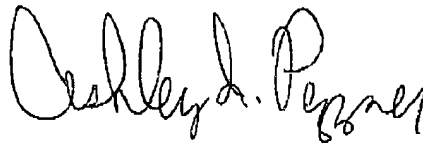
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03-2775, under Order No. 13077-00140-US from which the undersigned is authorized to
draw,

Respectfully submitted,

CONNOLLY, BOVE,
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